

II. Rejections Under 35 U.S.C. § 103(a)

**A. *Hanna et al.* (US Patent No. 5,843,417)**

Claims 1, 17-42, 49-52, 70-95 and 99 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,843,417 (“Hanna”). Office Action at p. 3. Applicants traverse this rejection for at least the following reasons.

The Examiner alleges that Hanna teaches “a water-in-oil (W/O) emulsion, wherein the oil is preferably a C10-C14 saturated, linear, or branched hydrocarbon (such as isododecane).” Office Action at p. 3. The Examiner also alleges that Hanna teaches pigment particles which may have a hydrophobic coating, at least two different surfactants, and other ingredients and additives as set forth at pp. 3-5 of the Office Action. According to the Examiner, Hanna further teaches that the W/O emulsion preferably contains from 20-55% water by weight and 10-55% oil, such as a hydrocarbon-based oil, and that additional oils, including volatile silicone oils, may be present. *Id.* at p. 4. The Examiner also asserts that Hanna discloses its W/O emulsion as preferably containing one or more surfactants such as dimethicone copolyol and cetyl dimethicone copolyol, among others. *Id.* To further support the rejection, citing M.P.E.P. 2144.05 and *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955), the Examiner states, “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation” *Id.* at p. 5.

Applicants respectfully disagree. Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application

under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or nonobviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. 467; see also *KSR Int'l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385, 1391 (2007).

Thus, in order to carry the initial burden of establishing a *prima facie* case of obviousness that satisfies the *Graham* standard, the Examiner must at least show (1) that the prior art reference teaches or suggests all the claim limitations, (2) that there is some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, and (3) that there is some reasonable expectation of success. See M.P.E.P. § 2143. And the Examiner still “bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” See *In re Fine*, 837, F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Here, with respect to the scope and content of the prior art, Hanna does not teach or suggest all of the present claim limitations. First, Hanna's composition does not contain a disclosure of at least 30% by weight of a volatile fatty phase within the fatty phase, wherein the volatile fatty phase comprises:

- at least 6% by weight, relative to the total weight of the emulsion, of at least one volatile hydrocarbon oil, and
- at least one volatile oil chosen from volatile silicone oils and volatile fluorinated oils.

The Examiner appears to rely on col. 2, line 62 - col. 3, line 40 of Hanna for a teaching of "10 -55% oil" in the w/o emulsion "wherein the oil is preferably a hydrocarbon-based oil (such as isododecane), additional oils may be present including silicone oils, including volatile silicone oils . . . " Office Action at p. 4. However, the Examiner's reliance on this passage is misplaced. In fact, Hanna largely teaches away from these elements, even in portions of the disclosure immediately adjacent to that relied upon by the Examiner. First, Hanna explicitly states that an object of the present invention is to provide a W/O emulsion product "which contains no silicone oil such as volatile silicones." Col. 1, lines 37-38. Second, although Hanna states, at col. 3, lines 33-36, that the "present invention oil may contain, in addition to the hydrocarbon oils, other oils... such as silicone oils, including volatile silicone oils," Hanna states just a few lines later that the "absence of silicone oils such as volatile silicone oils in the invention oil is another preferred embodiment." Col. 3, lines 43-44.

In Applicants' view, one of ordinary skill in the art reading Hanna would have been unlikely to use volatile silicone oils or indeed any volatile oils. Prior art must be considered in its entirety, including disclosures that teach away from the claims. M.P.E.P. §§ 2141.02 and 2143.01. The inconsistent and predominantly negative (i.e., regarding use of volatile oils) disclosure of Hanna cannot justifiably be considered support for a *prima facie* case of obviousness.

Second, Applicants submit that contrary to the Examiner's assertion, Hanna does not disclose or suggest introducing the specific combination of at least one C<sub>8</sub>-C<sub>22</sub> alkyl dimethicone copolyol (e.g., a cetyl dimethicone copolyol) and at least one other dimethicone copolyol as surfactants. At col. 4, lines 56-57, Hanna discloses that their compositions preferably comprise one or more surfactants. At col. 5, lines 3-7, Hanna mentions that the surfactant can be a "dimethicone copolyol, laurylmethicone copolyol, glyceryl stearate, beeswax, cetyl dimethicone copolyol, polyglyceryl-4-isostearate, hexyl laurate, etc." and that "mixtures of . . . surfactants may be used." However, there is no guidance in Hanna to specifically choose two surfactants, let alone the combination of a C<sub>8</sub>-C<sub>22</sub> alkyl dimethicone copolyol and a dimethicone copolyol. In fact, the composition in Hanna's example uses a three-surfactant mixture of cetyl dimethicone copolyol, polyglyceryl-4-isostearate and hexyl laurate. And, even assuming *arguendo* that one skilled in the art would have chosen two surfactants, certainly there is no teaching in Hanna that would have led one of ordinary skill in the art to specifically select those two corresponding to the present claims, with any reasonable expectation of success, and without the benefit of hindsight.

Accordingly, because Hanna does not teach or suggest all limitations of the present claims, this rejection under § 103(a) is in error and should be withdrawn.

***B. Hanna et al. in view of Elm et al. (US Patent No. 4,552,753)***

Claims 43-47 and 53-59 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,843,417 ("Hanna") as applied to claims 1, 17-42, 49-52, 70-95 and 99 above, and further in view of Elm et al. (US Patent No. 4,552,753),

and as evidenced by the Aldrich Catalog 2003-2004. Office Action at p. 6. The Examiner admits that Hanna does not teach the particular volatile linear or cyclic silicone oils as claimed or the flash points of said volatile silicone oils. *Id.* The Examiner attempts to correct this deficiency by citing Elm as teaching the linear or cyclic silicone oils. The Aldrich catalog is cited to teach the flash points of the oils taught by Elm. *Id.* at p. 6-7. The Examiner then states that it would have been obvious that the broadly disclosed volatile silicone oils of Hanna included those described by Elm and that one would have been motivated to choose any of the particular cyclic or linear volatile silicone oils as the general characteristics are similar and it would have been a matter of routine optimization to choose which oil would have been a best fit. *Id.* at p. 7.

Applicants disagree. As discussed above, Hanna fails to teach or suggest all the limitations of the present claims. Elm does not and cannot cure the deficiencies of Hanna.

Additionally, the M.P.E.P. specifically instructs that "it is improper to combine references where the references teach away from their combination." *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983), M.P.E.P. § 2145. As discussed above, Hanna teaches away from using the volatile silicone oils. Further, on May 3, 2007, following the Supreme Court's recent decision in *KSR Int'l. Co. v. Teleflex Inc.* (No. 04-1350 (US Apr. 30, 2007)), the Office issued a memorandum to its technology center directors indicating that **"in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed."** (Emphasis in

original). Here, the Examiner has failed to provide any explicit reason why one of ordinary skill in the art would pick and choose the specific oils of the secondary references when the primary reference largely teaches away from their use.

Thus, for at least the reasons discussed above, the Examiner has not established a *prima facie* case of obviousness, and Applicants respectfully request that the Examiner withdraw this rejection.

***C. Hanna et al. in view of Bara et al. (US Patent No. 6,224,851)***

Claims 48-52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,843,417 ("Hanna") as applied to claims 1, 17-42, 49-52, 70-95 and 99 above, and further in view of Bara (US Patent No. 6,224,851 B1). Office Action at p. 7.

The Examiner admits that Hanna does not teach the particular volatile fluorinated oils as claimed, and relies on Bara for teachings of make-up and sunscreen cosmetic compositions comprising at least one polyorganohalogen solvent wherein the halogen is fluorine. *Id.* at p. 7-8. The Examiner then reasons that it would have been obvious to us the particular fluorinated solvents of Bara in the formulations of Hanna because Hanna discloses the use of fluorinated oils in general, and Bara teaches that the volatile fluorinated solvents have better anti-transfer properties, and one would thereby have a reasonable chance of success for use in the current invention. *Id.* at p. 8. Applicants respectfully traverse.

As discussed above, Hanna fails to teach or suggest all the claimed limitations and Hanna teaches away from the use of volatile oils. Bara does not and cannot cure

these deficiencies of Hanna, so, for the same reasons set forth above, the rejection of claims 48-52 is also improper and should be withdrawn.

**CONCLUSION**

In view of the above, Applicants request the Examiner's reconsideration of the application, and the timely allowance of the pending claims. If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully invited to contact Applicants' undersigned counsel at 202-408-4454.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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